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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/651,676	08/29/2003	William G.F. Kelly	CHI-0869-CIP	9313

27777 7590 05/30/2006

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EXAMINER

COLE, ELIZABETH M

ART UNIT	PAPER NUMBER
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1771

DATE MAILED: 05/30/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/651,676

Applicant(s)

KELLY ET AL.

Examiner

Elizabeth M. Cole

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All .b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 5/8/06;3/20/06
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____

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1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 3/20/06 has been entered.

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1-14 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-4, 7-31, 35-45 of copending Application No. 10/651,676. Although the conflicting claims are not

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identical, they are not patentably distinct from each other because each discloses a two layered apertured structure having macrostructures which extend from one layer to the other layer, wherein both layers are fluid permeable.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

4. Claims 1-14 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification as originally filed does not provide support for the limitation that the aperture sidewalls originate in the first surface and terminate in the second plane and that the apertures defined by aperture sidewalls are spaced from said first layer. The specification provides support in figs 1 and 1A for the limitations regarding the aperture sidewalls being spaced from the first layer but does not provide support for that limitation when the apertures sidewalls originate in the first surface and terminate in the second plane, unless the second plane is not the same as the second surface.

5. Claims 1-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claim 1, it is not clear what is meant by "projecting therefrom" since the claim has been amended to recite first and second surfaces and a caliper defined by a first plane and a second plane. From which of these elements do

the macrofeatures project? Also with regard to claim 1, it is not clear what is meant by the limitation "said first surface is coincident with the first plane at said macrofeatures".

Does this refer to where the macrofeatures project from or does this refer to the tops of the macrofeatures? The claimed structure is not clear.

6. Also, it is not clear whether the first and second plane are the same as or different than the first and second surfaces and if they are different can any line be drawn at a point in the structure to indicate the first and second planes? The claimed structure is not clear.

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1-12, 14 are rejected under 35 U.S.C. 102(b) as being anticipated by Thomas, U.S. Patent No. 6,242,074.

Thomas discloses a topsheet for use with absorbent articles comprising a first layer of a nonwoven fabric 104 and a second layer 102 comprising a formed film. The formed film has first and second planar surfaces, a plurality of macrostructures which project from the first surface and whose tops define the second planar surface, apertures defined by aperture side walls wherein the aperture sidewalls are spaced from the top layer. The apertures begin in the first plane and terminate in the second plane. The nonwoven layer only contacts the formed film layer at the macrostructures. The formed

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film can have a thickness of 0.0005-0.111 inches and so would meet the limitations of claims 2-4. The first and second layers can be a nonwoven fabric or an apertured film. The formed film is an apertured film with macrofeatures. The apertured film can have a regular. The apertures have sidewalls which originate in the first plane and end in the second plane. With regard to claim 13, the sidewalls have a portion that is between the first and second plane. With regard to claim 14, it appears that the ratio of apertures to macrofeatures would be at least one. The macrofeatures are not apertured. The tops of the macrofeatures are planar.

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 1-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 94/20054 in view of Merz et al, U.S. Patent NO. 4,995,930. WO '054 discloses a material for a topsheet of a diaper comprising a plurality of macrostructures where in the film is even apertured so that there are some apertures at the macrostructures and some at the base of the macrostructures in the film. See page 1, line 27 – page 2, line 37; page 3, lines 1-14. WO'054 differs from the claimed invention because it does not disclose the particularly claimed dimensions of the macrofeatures and does not disclose providing a layer which contacts the first layer at the macrofeatures. With regard to the dimensions of the macrofeatures, since the macrofeatures are present in WO '054 to enhance the comfort of the user by spacing the skin from the film layer, it would have

been obvious to have selected the particular dimensions of the macrofeatures which provided optimum comfort and spacing. With regard to the nonwoven layer, Merz teaches that fibrous layers such as nonwoven fabrics can be laminated with apertured films for use in disposable hygiene products. Merz teaches that adding the fibrous layer improves the comfort of users of the hygiene products. See col. 1, lines 61-64.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have added a fibrous first layer to the top surface of WO '054, motivated by the expectation that this would enhance the comfort of the user of the absorbent article.

11. Applicant's arguments have been fully considered but are moot in view of the new grounds of rejection.

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Thomas et al, U.S. Patent No. 4,351,784.

13. Applicant's comments regarding the double patenting rejection are noted.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elizabeth M. Cole whose telephone number is (571) 272-1475. The examiner may be reached between 6:30 AM and 6:00 PM Monday through Wednesday, and 6:30 AM and 2 PM on Thursday.

Mr. Terrel Morris, the examiner's supervisor, may be reached at (571) 272-1478.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

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For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

The fax number for all official faxes is (571) 273-8300.

A handwritten signature in black ink, appearing to read "Elizabeth M. Cole". The signature is fluid and cursive, with the first name being the most prominent.

Elizabeth M. Cole
Primary Examiner
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e.m.c